

Appl. No. 10/038,319
Atty. Docket No. CM-2462
Amdt. dated October 4, 2004
Reply to Office Action of May 3, 2004
Customer No. 27752

REMARKS

Claims 1-20 are pending in the present application.

Claim 1 has been amended to include the term "perfume." Basis for the term "perfume" is found throughout the specification including the Examples. As such, no new matter is believed to be added.

No additional claim fees are believed due.

Rejection Under 35 USC 102(b) Over U.S. Pat. No. 5,540,952.

Claims 13, and 15-20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,540,952 (hereinafter "Canivenc"). Applicant traverses this rejection.

The Office Action at page 2, lines 10-11 is only partially correct by purporting that Canivenc teaches a textile softening process. Rather, Canivenc teaches a process used in the textile industry. More specifically, Canivenc at column 9, lines 32-36 discloses:

In the process according to the present invention, in order to apply the composition comprising the polysiloxane to the fabric to be treated, use is made of the conventional techniques of the textile industry, especially by resorting to the impregnation technique known as padding. (Emphasis added).

Thus, Applicant submits Canivenc is directed to applying composing comprising polysiloxane using techniques of the textile industry. In contrast, independent claims 13 is directed *inter alia* the treatment of clothes in a domestic process. As such, the Office Action's assertion at page 2, lines 12 that the softener of Canivenc is "used for the identical purpose" as the softener of the present claims is incorrect.

The Office Action at page 2, lines 21-23 alleges that the instructions, as recited by the present claims, "do not give rise to a new and useful function, effect or result, they do not contribute a patentable difference to applicant's invention." Applicant respectfully disagrees. The instructions instruct the consumer to use the composition in a domestic process. For example, the domestic process may include using the composition in the "last rinse of a

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conventional laundry cycle." In contrast, Canivenc's preferred method is a process known as padding which appears to be sometime of impregnation technique. Canivenc teaches away from domestic processes.

The Office Action finds that no patentable weight is given to instructions which are construed as intended use of the solution citing *In re Gulack*, 217 USPQ 401, 404. Applicant respectfully asserts the Office's reliance on *In re Gulack* is misplaced. Rather, *In re Gulack* holds for the principle:

Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of printed matter. Under section 103, the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. The claim must be read as a whole. If the Board meant to disregard that basic principle of claim interpretation, we must reverse the rejection as a matter of law. *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983).

Applicant submits the Office Action has acted contrary to the very jurisprudence that the Office Action cites to Applicant. The Office Action has dissected the present claim 15 and excised the instruction limitation (wherein instructions may be printed matter) from Claim 15, and has declared the remaining portion of the claim as unpatentable. Applicant asserts that claims must be read as whole. To not provide patentable weight to instructions, is to disregard the basic principle of claim construction.

In view of the foregoing, Claim 13 and 15-20 are novel over Canivenc.

Rejection Under 35 USC 103(a) Over U.S. Pat. No. 5,540,952; Over WO 97/33034; and
Over U.S. Pat. No. 5,147,578

Claims 1-20 have been rejected under 35 USC 103(a) as being unpatentable over US 5,540,952 (hereinafter "Canivenc"); Over WO 97/33034 (hereinafter "Branlard"); Over U.S. Pat. No. 5,147,578 (hereinafter "Kirk"). Applicant respectfully traverses this rejection as failing to establish a *prima facie* case of obviousness (see MPEP 2143.03).

a. Canivenc

The Office Action at page 3, lines 20-22, is correct as to characterizing the claims as drawn to a domestic process in contrast to an industrial process as taught by the prior art. However, the Office Action maintains that one of ordinary skill in the art, having in their position a composition with a proven utility of fabric softening in an industrial process, would have a reasonable expectation of success when using the same composition for the same

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reason, albeit in a domestic process. Applicants respectfully traverse this assertion. Rather, as explained at page 4, lines 5-18 of the specification:

It has now been found that there exists a particular class of aminosilcones which is suitable for use in a domestic context and which does not yellow fabrics. Such silicones have been discussed in, e.g. US 5,688,889 as well as US 5540952, but only for use in an industrial context, and for a different benefit. In particular, in example 3 of those documents, a process is described in which fabrics are immersed in a solution of the amino silicone in *white spirit*, and the fabrics are subsequently dried at 40°C for 15 minutes in a ventilated oven and then heated at 160°C for 30 min. This *pad-dry-cure* process is a standard process in textile industry, but it cannot be performed in a domestic context. (Emphasis Added)

Applicant asserts there simply cannot be *inter alia* a reasonable expectation of success of using this particular class of aminosilcones when the preferred process uses solvents such as "white spirits." This industrial cocktail hardly provides the requisite "reasonable expectation of success" for a domestic process. The conditions represented of the "pad-dry-cure process" using a ventilated oven fails to analogize to a domestic dryer thereby failing also to provide the requisite "reasonable expectation of success." Rather, the reference teaches away from using the aminosilcones from anything other than a standard process in the textile industry.

b. Branlard

With respect to Branlard, the Office Action at page 5, lines 6-10 maintains that one of ordinary skill in the art, having in their position a composition with a proven utility of fabric softening in an industrial process, would have a reasonable expectation of success when using the same composition for the same reason, albeit in a domestic process. Applicant submits that the reference fails to provides *inter alia* the request "reasonable expectation of success" that is required in establishing a *prima facie* case of obviousness.

Branlard, as the Office Action concedes, clearly discloses an industrial process of treating fabric. For example, at page 6, lines 33-35 the paragraph roughly translates as, "However, the composition, according to the process of the invention, can be equally used in solution with an organic solvent. This solvent can be for example toluene or xylene." (Emphasis added). Applicant submits that compositions comprising toluene and xylene as not

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suitable for domestic applications. Similarly at page 7, lines 9-17 the paragraphs roughly translates as:

The application of the polyorganosiloxane, according to the invention, on the material to be treated can be done many different ways. The applications can be done by immersion, coating, spraying, printing, padding, knife coating or by any other ways known in the art. (Emphasis added).

For example, when the fabric is treated by an aqueous composition comprising a polyorganosiloxane according to the invention, this fabric is subjected to a thermal treatment to drive water out quickly in the form of steam.

As to thermal treatment, Branlard provides examples where the treated fabric is exposed temperatures well above 300° F (*see e.g.*, page 21, lines 14-15; 22; and 31). Applicant submits that industrial techniques such as padding and knife coating fails to provide the requisite reasonable expectation of success of using the compositions in a domestic setting. Moreover, treating fabric to temperatures above 300° F clearly are above those capable of a domestic dryer and thus, also fails to provide the requisite reasonable expectation of success of using the compositions in a domestic setting.

c. Kirk

The Office Action at page 6, lines 6-8 alleges that the softener of Kirk may contain cyclohexane or pheny functional groups, thereby satisfying the "sterically hindered functional groups" citing column 2, lines 1-50 of the Kirk. In response, Applicant submits that Office Action has not established that that these functional groups alone provide "steric hinderence." Moreover, there is no suggestion that the use of the functional groups cyclohexane or pheny functional groups lead to reduced yellowing. As the specification explains at page 4, lines 5-7, "It has now been found that there exists a particular class of aminosilcones which is suitable for use in a domestic context and which does not yellow fabrics." Thus, the Office Action's citation to Kirk fails to establish a *prima facie* case of obviousness.

d. Case Law

Applicant respectfully asserts the Office Action misapplies the case law. The Office Action, for example, at page 4, lines 5-8, alleges that changes in temperature, concentration, or other process conditions of an old process do not impart patentability unless the recited changes are critical, i.e., they produce a new and unexpected result" citing *In re Aller* et al

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220 F.2d 454 (CCPA 1955) (Emphasis in original). The Office Action's emphasis on "or other process conditions" is misplaced. Rather, the emphasis in should be on the subsequent phrase: "of an old process" which distinguishes the facts from the present invention. Applicants claim a process of using a composition (i.e., "method of using") and not a process of making a composition. The Appellant in *In re Aller* was attempting to claim a process that was identical with that of the prior art, except that appellant's claims specified lower temperatures and higher sulphuric acid concentrations than were previously shown. The facts of *In re Aller* are clearly distinguishable from the present application which is claiming a new and unobvious method of using a composition (and not an improvement in *making* a composition).

The Office Action, at page 4, lines 8-12 alleges that "the composition being used in a domestic process could be construed as intended use of the composition and that it is well established that the mere recital of a different intended use in a claim does not distinguish the claim of the composition containing the same ingredient in the same proportion for a different purpose in the prior art" citing *In re Zierden*, 162 USPQ 102. In response, Applicant respectfully submits although *In re Zierden* does stand for the principle, "A mere statement of a new use for an otherwise old or obvious composition cannot render a claim to the composition patentable" (56 C.C.P.A. 1223, 1227 (CCPA 1969)), Applicants are NOT claiming a composition, but rather a new method. In fact, the *In re Zierden* court recognizes this distinction. The court reversed the rejection of the method claims because the new use of a known process was patentable since it was not anticipated by an existing patent or obvious to one skilled in the art. The same facts apply in the present here. Applicants are not claiming a composition, but rather a novel and unobvious method of using a composition.

Lastly, the Office Action's reliance on *In re Thuau*, 30 C.C.P.A. 979 (CCPA 1943) is outdated. Indeed the change in the statute, Section 100(b), of the Patent Act of 1952 *overturned* the former doctrine that new uses of old materials and processes were not patentable and in fact provided for the patentability of new uses of known processes, materials or compositions. The Office Action's citation to this 1943 case fails to take in account changes in the Patent Act, most notable in 1952.

e. Perfume claim limitation

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Without conceding that the Office Action has met its burden of establishing a *prima facie* case of obviousness and only in the interests of expediting prosecution, Applicant amends Claim 1 by including the limitation "perfume" to further distinguish the invention from the cited references. The cited references, directed to industrial processes and composition, fails to suggest *inter alia* a composition comprising an aminosilicone and a perfume.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 USC §§ 102 and 103. Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendment presented herein, and allowance of Claims 1-20.

Respectfully submitted,
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